

ESTTA Tracking number: **ESTTA750644**

Filing date: **06/06/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Mozza, LLC		
Entity	Limited Liability Company	Citizenship	California
Address	45 East 20th Street, 3rd floor New York, NY 10003 UNITED STATES		

Attorney information	Lisa A. Ferrari Cozen O'Connor 277 Park Avenue New York, NY 10172 UNITED STATES lferrari@cozen.com, tmdocketing@cozen.com Phone:212-297-2699
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Registration Subject to Cancellation

Registration No	3975466	Registration date	06/07/2011
Registrant	Parasole IP, LLC 5032 France Avenue South Edina, MN 55410 UNITED STATES		

Goods/Services Subject to Cancellation


Class 043. First Use: 2010/11/00 First Use In Commerce: 2010/11/00 All goods and services in the class are cancelled, namely: Restaurant and bar services
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3407311	Application Date	08/24/2006
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	M PIZZERIA MOZZA		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2006/11/14 First Use In Commerce: 2006/11/14 restaurant and bar services

U.S. Registration No.	3386960	Application Date	08/24/2006
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	OSTERIA MOZZA M		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 043. First use: First Use: 2007/07/13 First Use In Commerce: 2007/07/13 restaurant and bar services
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U.S. Registration No.	3898988	Application Date	01/15/2010
Registration Date	01/04/2011	Foreign Priority Date	NONE

Word Mark	M PIZZA MOZZA 2GO
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Design Mark	
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Description of Mark	The mark consists of the letter "M" with a circle design on top of the "M" with the words ".Pizza." and "2go" with a fanciful banner on top of the circle with the word "mozza".
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Goods/Services	Class 043. First use: First Use: 2009/06/30 First Use In Commerce: 2009/06/30 Restaurant and bar services
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Attachments	78959463#TMSN.png(bytes) 78959451#TMSN.png(bytes) 77912965#TMSN.png(bytes) MOZZA MIA Petition for Cancellation.pdf(624767 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Lisa A. Ferrari/
Name	Lisa A. Ferrari
Date	06/06/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,975,466

Registered: June 7, 2011

Mark: MOZZA MIA

MOZZA, LLC,)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	
)	
PARASOLE IP, LLC,)	
)	
Registrant.)	

PETITION FOR CANCELLATION



MOZZA, LLC (“Mozza” or “Petitioner”), a California limited liability company with a place of business at 45 East 20th Street, 3rd floor, New York, New York 10003, believes that it will be damaged by the continued registration of the mark MOZZA MIA shown in U.S. Registration No. 3,975,466 (the “Registered Mark”), owned by PARASOLE IP, LLC (“Registrant”), a Delaware limited liability company with a place of business at 5032 France Avenue, South Edina, Minnesota 55410, and hereby petitions to cancel same (the “Petition”). Mozza petitions for cancellation on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). In support of its Petition, Mozza asserts as follows:


MOZZA'S MARKS

1. Mozza owns trademarks that have been continuously used in connection with restaurant and bar services at the world-renowned Pizzeria Mozza, Osteria Mozza, and Mozza2Go restaurants and eateries in Los Angeles, California and elsewhere (the “Mozza Restaurants”).

2. The Mozza Restaurants have been operated by Mozza’s principals, the world-famous chef/restaurateurs Mario Batali, Joseph Bastianich and Nancy Silverton. The first Mozza Restaurant, Pizzeria Mozza, opened in Los Angeles in 2006, and was followed by Osteria Mozza which opened in 2007, and Pizza Mozza2Go which opened in 2009. Mozza has also opened Mozza Restaurants in Newport Beach, California and outside the U.S.

3. In connection with its operation of the Mozza Restaurants, Mozza owns the following design plus word marks, all of which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office (“USPTO”), and together which are referred to herein as the “MOZZA Registrations”:

Registration No.	Mark	Goods/Services and International Class	First Used in Commerce
3,407,311 (M PIZZERIA MOZZA)		“Restaurant and bar services” in Class 43	Nov. 14, 2006
3,386,960 (OSTERIA MOZZA M)		“Restaurant and bar services” in Class 43	July 13, 2007

3,898,988 (M PIZZA MOZZA 2GO)		"Restaurant and bar services" in Class 43	June 30, 2009
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4. The MOZZA Registrations have each attained incontestable status pursuant to 15 U.S.C. §§ 1065 and 1115.

5. In addition to the MOZZA Registrations, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. Mozza has promoted and delivered its restaurant and bar services to a national and international clientele. Mozza owns and operates websites at the domains <http://www.pizzeriamozza.com>, <http://www.osteriamozza.com>, and <http://www.mozza2go.com>, through which it promotes and advertises its restaurant and bar services throughout the United States and elsewhere. As a result of Mozza's wide-ranging promotional activities, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. The marks shown in the MOZZA Registrations, together with Mozza's extensive common law rights, are collectively referred to herein as the "MOZZA Marks."

6. Mozza has expended substantial sums of money in marketing, advertising and promoting its MOZZA Marks and, through such sales and advertising, has generated substantial goodwill and customer recognition in the MOZZA Marks. The public has come to associate the MOZZA Marks exclusively with Mozza.

7. Mozza has derived substantial revenues from the sale of restaurant and bar services under the MOZZA Marks.

8. Mozza's extensive use and advertising of the MOZZA Marks has resulted in consumer recognition that the MOZZA Marks identify Mozza as the source of high-quality food

and wine. The MOZZA Marks are distinctive of Mozza's services and are well known and famous. Valuable goodwill has been generated in the MOZZA Marks, and such goodwill was generated long before the filing date of the Registered Mark.

Registrant's Registration for MOZZA MIA

9. On February 15, 2010, Registrant filed an intent-to-use application to register the mark MOZZA MIA in connection with "restaurant and bar services" in International Class 43. The application was assigned Serial No. 77/935,634.

10. Following the examination and publication of the application by the U.S. Patent and Trademark Office, Registrant was issued U.S. Registration No. 3,975,466, *i.e.*, the Registered Mark, on June 7, 2011.

11. Registrant's Mark lacks incontestable status pursuant to 15 U.S.C. § 1065, 1115.

12. Registrant's use and registration of the Registered Mark in connection with restaurant and bar services was and is without the consent or permission of Mozza.

13. Long before Registrant's first use and filing of the Registered Mark, Mozza adopted, first used, and registered the MOZZA Marks on or in connection with restaurant and bar services. Since then, Mozza has continuously used and not abandoned the MOZZA Marks.

14. The services for which Registrant has registered and uses the Registered Mark are identical to the services in connection with which the MOZZA Marks are used and for which Mozza owns registrations.

COUNT I - LIKELIHOOD OF CONSUMER CONFUSION

15. Mozza repeats and realleges the allegations of paragraphs 1 through 14 above, as though fully set forth herein.

16. Mozza has used the MOZZA Marks in United States commerce prior to Registrant's adoption, use of, and application to register the Registered Mark. Mozza registered each of the MOZZA Marks prior to Registrant's adoption, use of, application to register, and registration of the Registered Mark.

17. Registrant's mark, MOZZA MIA, is confusingly similar to Mozza's MOZZA Marks.

18. Based on the foregoing, the continued registration of the mark MOZZA MIA by Registrant in connection with restaurant and bar services is likely to cause confusion, mistake or deception that Registrant's services are those of Mozza or are otherwise endorsed, sponsored or approved by Mozza, or cause confusion, mistake or deception as to the affiliation, connection or association between Registrant and Mozza.

19. If Registrant is permitted to continue to use and register Registrant's Mark in connection with restaurant and bar services, confusion in trade resulting in irreparable damage and injury to Mozza would be caused by reason of the similarity between Registrant's Mark and Mozza's MOZZA Marks. Consumers are likely to buy Registrant's services incorrectly believing that such services are provided by, endorsed by or associated with Mozza.

20. If Registrant is granted continued registration of Registrant's Mark, Registrant will maintain a *prima facie* exclusive right to use the Registered Mark, and such continued registration would be the source of irreparable damage and injury to Mozza.

21. Accordingly, the Registered Mark should be cancelled under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended.

COUNT II - DILUTION

22. Mozza repeats and realleges the allegation of paragraphs 1 through 21 above, as though fully set forth herein.

23. Registrant's commercial use of the Registered Mark in United States commerce in connection with restaurant and bar services dilutes, or is likely to dilute, the distinctive quality and reputation of the MOZZA Marks under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

24. Upon information and belief, Registrant's use of the Registered Mark commenced after the date on which Petitioner's MOZZA Marks became famous.

25. If Registrant is permitted continued use and registration of the Registered Mark in connection with restaurant and bar services, dilution of the distinctive quality and reputation of Mozza's famous MOZZA Marks would result in irreparable damage and injury to Mozza.

26. Accordingly, Registrant's Mark should be cancelled under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), as amended.

PRAYER FOR RELIEF

WHEREFORE, Petitioner Mozza, LLC prays that the mark shown in U.S. Registration No. 3,975,466 be cancelled, and this cancellation proceeding be sustained in Petitioner's favor.

Mozza, LLC submits herewith the requisite filing fee in the amount of \$300. The Board is authorized to charge PTO Deposit Account No. 503111 for any additional charges or fees related to this filing.

Dated: June 6, 2016

Respectfully submitted,

COZEN O'CONNOR

/s/ Lisa A. Ferrari

Lisa A. Ferrari

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Attorneys for Petitioner Mozza, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on June 6, 2016, a copy of the foregoing **PETITION FOR CANCELLATION** is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at <http://estta.uspto.gov/>.

/s/ Lisa A. Ferrari

CERTIFICATE OF SERVICE

I hereby certify that on June 6, 2016, copies of the foregoing **PETITION FOR CANCELLATION** have been served upon Registrant, addressed as follows:

Via First-Class U.S. Mail, postage prepaid
Parasole IP, LLC
5032 France Avenue
South Edina, Minnesota 55410
Registrant

Via First-Class U.S. Mail, postage prepaid, and electronic delivery
Jennifer A. Forbes, Esq.
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Attorneys for Registrant Parasole IP, LLC

/s/ Lisa A. Ferrari